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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,612	02/25/2004	Gregory D. Cuny	SPV-046.02	2037
25181	7590	08/03/2005	EXAMINER	
FOLEY HOAG, LLP			SHIAO, REI TSANG	
PATENT GROUP, WORLD TRADE CENTER WEST			ART UNIT	
155 SEAPORT BLVD			PAPER NUMBER	
BOSTON, MA 02110			1626	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/786,612

Applicant(s)

CUNY ET AL.

Examiner

Robert Shiao

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on responses filed on 06/13, 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-36 and 45-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 25-36 and 45-58 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/01/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This application claims benefit of the provisional applications:

60/284,159 with a filing date 04/17/2001; and

60/313,648 with a filing date 08/20/2001.

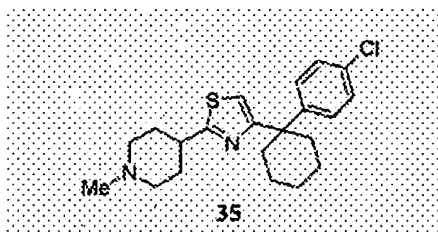
2. The amendment to the claims filed on June 13, 2005, does not comply with the requirements of 37CFR 1.121(c) because of failure to provide a marked up version of the amended claim. Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) Claims . Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered)

3. Claims 1-24, 37-44, and 59-106 have been cancelled, claims 25-36 and 45-58 are pending in the application.

***Responses to Election/Restriction***

4. Applicant's election without traverse of Group III claims 25-36 and 45-58, in part, in the reply filed on June 13, 2005, is acknowledged. Applicants also elected a species



of the formula , is also acknowledged.

***Status of the Claims***

5. Claims 25-36 and 45-58 are pending in the application. The scope of the invention of the elected subject matter is as follows:

Claims 25-36 and 45-58, in part, drawn to compounds/compositions of formula (C), wherein the variable W represents CH<sub>2</sub> or O thereof; the variable X represents S thereof; the variable Y represents CR' thereof; the variables p, n, and m are as defined in claim 25; the heteroaryl of variable R<sub>2</sub> represents 5-chlorobenzo[b]-thiophen-3-yl thereof; variables R<sub>1</sub> and R<sub>4</sub> with the adjacent nitrogen form a ring piperidine thereof; variables R<sub>3</sub> and R<sub>4</sub> are not connected together to form a covalent bond thereof; and -N(R<sub>4</sub>)(R<sub>5</sub>) may represent 4-morpholinyl thereof.

Claims 25-36 and 45-58, in part, embraced in above elected subject matter, are prosecuted in the case. Claims 25-36 and 45-58, in part, not embraced in above elected subject matter, are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and is therefore made **FINAL**.

### ***Objection***

6. Claims 25-36 and 45-58 are objected to as containing non-elected subject matter, i.e., variable Y does not represent N, R<sub>2</sub> does not represent heteroaryl, variables R<sub>3</sub> and R<sub>4</sub> are not connected together to form a covalent bond, etc. It is suggested that applicants amend the claims to the scope of the elected subject matter as defined on the page 3 *supra*.
7. Claims 45-58 are objected to as depending on the cancelled invention, i.e., claims 1, 17 and 37. Elimination of the term "claim 1, 17, 25, or " of the claims respectively would obviate the objection.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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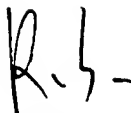
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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August 01, 2005